

REMARKS

Claims 22-81 are pending in the Application and all have been rejected in the Office action mailed August 17, 2010. No claims are amended by this response. Claims 22, 28, 29, 36, 43, 47, 51 and 60 are independent claims. Claims 23-27 and 74, claim 75, claims 30-35 and 76, claims 37-42 and 77, claims 44-46 and 78, claims 48-50 and 79, claims 52-59 and 80, and claims 61-73 and 81 depend, respectively, from independent claims 22, 28, 29, 36, 43, 47, 51, and 60.

The Applicants respectfully request reconsideration of pending claims 22-81, in light of the following remarks.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth "all reasons and bases" for rejecting the claims.

As noted above, no claims are amended by this submission. Therefore, Applicants respectfully submit that no new issues are raised that necessitate a new search.

Rejections of Claims

Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken (WO 91/08629) in view of Richter, et al. (US 6,104,706, hereinafter "Richter'706") and Fuller, *et al.* (US 5,375,161, hereinafter "Fuller"). Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Fuller, and Harrison (US 5,796,727). Claims 27, 35, and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Fuller, and Weaver et al. (US 5,956,673, hereinafter "Weaver"). Claims 51 and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Fuller, and Weaver. Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Fuller, and Perkins (US 5,159,592). Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, Harrison, and Perkins. Claims 52 and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, Weaver, and Perkins. Claims 55 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, and Cripps (US 5,838,730). Claims 74-77 and 79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, and Dezonno (US 5,991,394). Claim 78 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, Harrison, and Dezonno. Claim 80 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, Weaver, and Dezonno.

Claims 60-62 and 68-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, *et al.* (US 6,108,704, hereinafter "Hutton"), and further in view of Reimer, *et al.* (US 4,704,696, hereinafter "Reimer"). Claims 63-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Hutton, and Reimer, in further view of Lewen, *et al.* (US 5,341,374, hereinafter "Lewen"). Claim 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Hutton, Reimer, and Lewen, in further view of McKee, *et al.* (US 5,477,531, hereinafter "McKee"). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over

Berken, Hutton, and Reimer, in further view of Cripps (US 5,838,730). Claim 81 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Hutton, and Reimer, in further view of Dezonno. Applicants respectfully traverse the rejections.

Applicants respectfully note that all of the rejections are for alleged reasons of obviousness.

Applicants first review the requirements for an obviousness rejection. According to M.P.E.P. §2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” (emphasis added) M.P.E.P. §2142 further states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is **the clear articulation of the reason(s) why the claimed invention would have been obvious.**” (emphasis added) As recognized in M.P.E.P. §2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit.**” (emphasis added) In addition, the Federal Circuit has made clear that “**rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396. (emphasis added)

In addition, as noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP at 2143.03. Further, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” See *id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination. Instead, all the words in a claim must be considered during the examination process.

Applicants respectfully submit that the Office action has failed to establish a *prima facie* case of obviousness with respect to any of claims 22-81, in accordance with M.P.E.P. §2142 and M.P.E.P. §2143.03, and respectfully traverse the rejections for the reasons set forth during prosecution, and those that follow.

I. The Proposed Combination Of Berken, Richter'706, And Fuller Does Not Render Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, And 57-59 Unpatentable

Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706 and Fuller. Applicants respectfully traverse the rejection.

As an initial matter, Applicants respectfully note that the response by the Office to Applicants' arguments of June 1, 2010 states, in its entirety:

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Please see response below:

In response to applicant argument, further, although memory may be used to store contents of a database, a memory does not necessarily comprise a "database," and therefore does not inherently comprise a "database." See M.P.E.P. §2112. Further, even if Applicants were to agree that "memory 217" comprised a "database," which Applicants do not, Berken fails to teach or suggest that "memory 217" comprises a "database" having "at least one entry comprising user defined call routing information and at least one associated destination address." Applicants respectfully submit that the Office has not shown where Berken teaches, suggests, or discloses that "memory 217" contains anything that is "user defined." (see newly cited reference Fuller et al.)

In response to applicant argument, Applicants respectfully submit that although FIG. '1A of Berken shows a

"SUBSCRIBER LINE 141," "PSTN 151," "ETHERNET 143," and "ETHERNET LAN 153," there is nothing in FIG. 1A that teaches, suggests, or discloses "delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network." There is simply nothing in FIG. 1A that teaches user selection, as claimed. In addition, the Office fails to provide the required "explicit analysis" to explain how and why FIG. 1A teaches what is asserted. Applicants respectfully request, should the Office choose to maintain the rejection, that the Office provide the required "explicit analysis" to provide a clear and detailed explanation of how and why the Office is interpreting the disclosure of Berken as teaching what is asserted (see newly cited reference Fuller et al.).

Notably, the "Response to Arguments" shown above is not a response to the substance of Applicants' arguments, but is instead simply a summarization of two of the many points made by the Applicants in traversing the rejection of the Office, and does not, in fact, address the substance of those or any other of Applicants' arguments of the June 1, 2010 response. Instead, the Office directs the Applicants to "see newly cited reference Fuller et al." Applicants respectfully submit that the Office did not even attempt to rebut Applicants' arguments with respect to the Berken and Richter references, and instead introduces a new reference, Fuller.

The Office then asserts the rejection of claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 under 35 U.S.C. §103(a) over Berken, Richter'706, and Fuller. Applicants respectfully submit that the arguments addressing the alleged teachings of Berken and Richter'706 that appear on pages 3-7 of the instant Office action are identical to the arguments presented in the Office action of February 1, 2010. Compare August 17, 2010 Office action at pages 3-7 and February 1, 2010 Office action at pages 15-18.

Applicants have addressed those arguments during prosecution, most recently in the response filed June 1, 2010, and will not repeat the text of Applicants' response of June 1, 2010 again here. Instead, Applicants hereby incorporate the response of June 1, 2010 herein as though set forth in full. Again, Applicants respectfully note that the

substance of those repeated arguments was not addressed by the Office, **as required by M.P.E.P. §707.07(f)**.

Therefore, Applicants respectfully submit that the Office again fails to address the substance of Applicants' response to the repeated rejections over the proposed combination of Berken and Richter'706. Further, Applicants respectfully submit that, by introducing the Fuller reference, the Office seemingly admits that the proposed combination of Berken and Richter'706 does not teach the subject matter of Applicants' claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 for which the Office now turns to Fuller.

With regard to independent claim 22, Applicants respectfully submit that claim 22 recites, in part, "a database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." Independent claims 28, 29, 36, and 47 recite similar language. Applicants respectfully submit that the cited art does not teach, suggest, or disclose all aspects of Applicants' claim 22.

Applicants appreciate recognition by the Office that the proposed combination of Berken and Richter'706 fails to disclose, at least, "database having at least one entry comprising user defined call routing information and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." *See* August 17, 2010 Office action at page 7. The Office, however, then mistakenly relies upon Fuller, stating in part, the following, at pages 7-8:

However, Fuller et al. from a similar field of endeavor disclose a database having at least one entry comprising user defined call routing information (see column 21 lines 27-40, column 23 lines 7-33, column 21 lines 49-51) and at least one associated destination address, the database for use in voice call routing to cause delivery of voice to a called

party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database (see column 21 lines 51-55, Figure 2, call is branched out to PSTN or packet). Thus, it would have been obvious to one ordinary skill in the art at the time of invention was made to include Fuller et al. database scheme into Berken and Richter transmission scheme. The method can be implemented in a database. The motivation of doing this is to schedule calls based on user defined parameters.

By the above, the Office asserts that all aspects of Applicants' claimed "database" recited by claim 22 are taught by the cited portions of Fuller at col. 21, lines 27-40, col. 21, lines 49-51, col. 21, lines 51-55, col. 23, lines 7-33, and unidentified aspects of FIG. 2. Applicants respectfully disagree. Applicants begin by reviewing Fuller at col. 21, lines 27-40, which states:

A diagram of the Subscriber Master Record, reference 700, is illustrated in FIG. 7. The subscriber master record contains information regarding a given subscriber's chosen method of call handling. This information is used by the Telephone Control System 1 to determine how to process the call. One unique subscriber master record exists for each subscriber to the Telephone Control System 1. All subscriber master records are stored in disk 505 and, upon initialization of the Telephone Control System 1, are copied to a common database in RAM memory 500 by CPU 495. This facilitates fast retrieval of this information, which is necessary for the real-time processing of calls to the access control system 1.

The cited portion of Fuller reproduced above describes the "Subscriber Master Record 700" of FIG. 7, as containing "information regarding a given subscriber's chosen method of call handling," and that "[t]his information is used by the Telephone Control System 1 to determine how to process the call." Fuller also teaches that "[o]ne unique subscriber master record exists for each subscriber to the Telephone Control System 1." There is nothing in this cited portion of Fuller, however, that teaches, suggests, or

discloses a "packet," or a "packet-based network," or "a user selected one of a circuit switched network and a packet-based network," let alone Applicants' claimed "database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network." Therefore, the cited portion of Fuller at col. 21, lines 27-40 does not teach at least these aspects of Applicants' claim 22 admittedly absent from Berken and Richter'706. Applicants now review Fuller at col. 21, lines 49-51 and col. 21, lines 51-55, which are shown underlined in context, below:

Still referring to FIG. 7, the subscriber master record 700 contains as it's first element an access (DID) number, shown at reference 701. As described earlier, this access number 701 is the unique phone number which is used to reach a given subscriber via the Public Switched Telephone Network 2. A PIN code, which is used by the subscriber to identify himself to the Telephone Control System 1, is shown at 702. At 703, a call handling mode is shown. The call handling mode defines the basic method of call handling which has been chosen by the subscriber. Possible call handling modes include direct forwarding, announced forwarding, message center, voice screen forwarding, urgent screen forwarding, VIP code screen forwarding, and branch-routing. At 704, a standard greeting type is shown.

The cited portion shown above teaches a "call handling mode 703" chosen by the subscriber, which includes the "branch-routing" identified by the Office. The Office asserts that Fuller teaches "call is branched out to PSTN or packet." However, the portion of Fuller shown above, specifically chosen by the Office, makes no mention of a "packet," or of a "packet-based network," or of "a user selected one of a circuit switched network and a packet-based network," let alone Applicants' claimed "database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network," as recited by claim 22. Further, the Office has not identified where Fuller supports the assertion by the Office that a "call is branched out to PSTN or packet [network]." The cited portions of Fuller do not provide the support required by M.P.E.P. §2142 for such an assertion. Therefore,

Applicants respectfully submit that the cited portions of Fuller at col. 21, lines 49-51 and col. 21, lines 51-55 also do not teach, suggest, or disclose at least these aspects of claim 22 admittedly absent from Berken and Richter'706. Applicants now consider the final cited portion of Fuller at col. 23, lines 7-33, which is reproduced below:

A diagram of a Mode Memory, reference 800, is illustrated in FIG. 8. As described previously, the mode memories are used by subscribers of the Telephone Control System 1 to store their commonly used call handling modes and options. As with the subscriber master records 700, the mode memories 800 are stored in disk 505 and, upon initialization of the Telephone Control System 1, are copied to a common database in RAM memory 500 by CPU 495. Each mode memory is unique to an individual subscriber, and is identified by storing the subscriber's ACCESS NUMBER as part of the mode memory, as shown at reference 801. In the preferred embodiment, the subscriber may have up to 90 mode memories. Each mode memory is identified by a unique mode memory number, 10 through 99. This mode memory number is shown stored as part of the mode memory 800 at reference 802. Shown generally at reference 803, are the various fields which the subscriber has selected to store in the mode memory 800. As can be seen, these are a subset of the fields which are stored in the subscriber master record 700. To invoke a mode memory, the Telephone Control System 1 need only copy the fields from the mode memory 800 to the corresponding fields in the subscriber master record 700. The access control system 1 also copies the mode memory number 802 to the current feature memory field '715 of the subscriber master record 700.

The cited portion of Fuller shown above simply describes FIG. 8, which shows a "mode memory 800," which includes a subset of the fields stored in the "Subscriber Master Record 700." Fuller explains that the fields of any one of up to 90 "mode memories" of a subscriber, such as "mode memory 800" of FIG. 8, are copied to the corresponding fields of the "Subscriber Master Record 700" by the "Telephone Control System 1." Applicants respectfully submit, however, that this cited portion of Fuller fails to make any mention of a "packet," or of a "packet-based network," or "a user selected

one of a circuit switched network and a packet-based network," let alone teach or suggest Applicants' claimed "database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network," as recited by claim 22. Therefore, Applicants respectfully submit that the cited portion of Fuller at col. 23, lines 7-33 does not teach, suggest, or disclose at least these aspects of claim 22 admittedly missing from Berken and Richter'706.

The Office also vaguely suggests that FIG. 2 of Fuller somehow supports the rejection of Applicants' claimed "database" of claim 22. The Office fails to provide the required explanation of just what in FIG. 2, or the related text, teaches any of the aspects of Applicants' claimed "database." Applicants respectfully submit that while FIG. 2 shows a "packet radio transceiver 9," a review of Fuller reveals that the "packet radio transceiver 9" is used for receiving and transmitting data messages by radio from/to a "communicator 11" carried by a subscriber, to physically locate and audibly alert the subscriber, and to allow the subscriber to change the call handling method of the "Telephone Control System 1." *See, e.g.*, col. 7, line 65 to col. 8, line 9; col. 16, lines 11-49; col. 17, lines 20-28. Applicants respectfully submit that Fuller fails to teach, suggest, or disclose, however, delivery of voice by the "packet radio transceiver 9," and therefore does not teach, suggest, or disclose Applicants' "packet-based network" of Applicants' claim 22. It necessarily follows that FIG. 2 of Fuller also does not teach, suggest, or disclose "a user selected one of a circuit switched network and a packet-based network," let alone teach or suggest Applicants' claimed "database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network," as recited by claim 22. Therefore, Applicants respectfully submit that neither FIG. 2, nor any text related to FIG. 2, nor any of the remaining disclosure of Fuller teaches, suggests, or discloses at least these aspects of claim 22 admittedly missing from Berken and Richter'706.

Based at least upon the above, Applicants respectfully submit that Fuller does not teach, suggest, or disclose, at least, "a database having at least one entry comprising user defined call routing information and at least one associated destination

address, the database for use in voice call routing to cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database." In view of the admission that the proposed combination of Berken and Richter'706 also does not disclose at least these features of claim 22, and therefore that none of Berken, Richter'706, and Fuller disclose at least these features of claim 22, it necessarily follows that the proposed combination of Berken, Richter'706, and Fuller cannot, by definition, teach, suggest, or disclose at least these aspects of claim 22. Applicants respectfully submit that claims 23-27 and 74 depend from independent claim 22 and are therefore also allowable over Berken and Richter'706. Accordingly, Applicants respectfully request that the rejection of claims 22, 25, and 26 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

With respect to independent claims 28, 29, 36, and 47, Applicants respectfully submit that those claims were rejected over the same proposed combination of Berken, Richter'706, and Fuller, citing the same portions of the references using the same arguments set forth by the rejection of claim 22, and are therefore also allowable over the proposed combination of Berken, Richter'706, and Fuller for at least the reasons set forth above. Further, because claim 75 depends from allowable claim 28, claims 30-35 and 76 depend from allowable claim 29, claims 37-42 and 77 depend from allowable claim 36, and claims 48-50 and 79 depend from allowable claim 47, Applicants respectfully submit that those claims are also allowable over the cited art, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

II. Berken, Richter'706, And Fuller In Combination With Any Of Harrison, Weaver, Perkins, Cripps, And Dezonno Do Not Render Claims 23, 24, 27, 30, 31, 35, 37, 38, 42-46, 48, 49, 51-56, 74-80 Unpatentable

Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Fuller, and Harrison. Claims 27, 35, 42, 51, and 54

were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Fuller, and Weaver. Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter'706, Fuller, and Perkins. Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, Harrison, and Perkins. Claims 52 and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, Weaver, and Perkins. Claims 55 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, and Cripps. Claims 74-77 and 79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, and Dezonno. Claim 78 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, Harrison, and Dezonno. Claim 80 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Richter'706, Fuller, Weaver, and Dezonno. Applicants respectfully traverse the rejections.

With respect to independent claims 43 and 51, Applicants respectfully note that the rejections of claims 43 and 51 are based on Berken, Richter'706, and Fuller, that claims 43 and 51 recite language relating to the claimed "database" aspect that is similar to that recited by claims 22, 28, 29, 36, and 47, and that the Office relies on the same portions of Berken, Richter'706, and Fuller, and the same arguments in rejecting claims 43 and 51 as set forth in rejecting that aspect of claims 22, 28, 29, 36, and 47. Applicants have shown that the proposed combination of Berken, Richter'706, and Fuller does not teach aspects common to claims 22, 28, 29, 36, 43, 47, and 51. Further, the Office has not asserted that Harrison, Weaver, Perkins, Cripps, and/or Dezonno, taken alone or in combination remedy the shortcomings of the Berken, Richter'706, and Fuller references, set forth above. Therefore, Applicants respectfully submit that the Office has not shown that the proposed combinations of Berken, Richter'706, and Fuller, with Harrison, Weaver, or any of the other cited references, teaches, suggests, or discloses all aspects of Applicants claims 43 and 51, as required by M.P.E.P. §2142 and §2143.03. Therefore, Applicants respectfully submit that claims 43 and 51 are not rendered unpatentable by the cited art, and that claims 43 and 51,

and any claims that depend therefrom, are allowable over the proposed combinations of references for at least the reasons set forth above.

With respect to claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 44-46, 48, 49, and 52-56, and 74-80, Applicants respectfully submit that claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 44-46, 48, 49, 52-56, and 74-80 depend from independent claims 22, 28, 29, 36, 43, 47, and 51 that have been shown to be allowable over the cited art. Applicants respectfully submit that claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 44-46, 48, 49, 52-56, and 74-80 are therefore also allowable for at least the reasons set forth above with respect to their respective independent claims 22, 28, 29, 36, 43, 47, and 51.

With further respect to claims 74-80, Applicants respectfully submit that claim 74 recites, in part, "[t]he system of claim 22, wherein a user is prompted to select delivery of voice to the called party by one of the circuit switched network and the packet-based network, if such prompting is indicated by a user defined parameter." Claims 75-80 recite similar language. Applicants respectfully submit that the cited art does not teach all aspects of claim 74.

Applicants respectfully submit that the Office cites over a full page of Dezonno, but fails to specifically identify and explain, as required by M.P.E.P. §2142, what of the cited portions of Dezonno teaches Applicants' claim 74, **and how**. M.P.E.P. §2142 clearly recognizes that **"[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness,"** that **"[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious,"** and that **"the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit."** M.P.E.P. §2142 also recognizes that **"rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."**

Applicants' claim 74 recites "wherein a user is prompted to select delivery of voice to the called party by one of the circuit switched network and the packet-based

network, if such prompting is indicated by a user defined parameter.” The Office admits that “Neither Berken nor Richter and Fuller explicitly disclose a user is “prompted.”” See August 17, 2010 Office action at page 22. Applicants respectfully submit that the deficiencies of Berken, Richter’706, and Fuller are not limited to “prompted,” as demonstrated above. Applicants respectfully submit that the Office has not shown where the cited art teaches the remaining aspects of claim 74. Applicants have shown above that Fuller does not teach what is asserted in this rejection. Further, although the Office asserts that elements of FIG. 1 and FIG. 2 teach Applicants’ claim 74, there is nothing in FIG. 1 or FIG. 2 that makes any mention or suggestion of prompting a user, as claimed.

In addition, Applicants respectfully submit that the Office does not explain what of Dezonno is being identified as corresponding to Applicants’ claimed “prompt a user,” and how Dezonno teaches how a “telephone number or name” entered by a user, as in Dezonno, indicates that “prompting” should occur. Of the cited portions of Dezonno, only the text of claim 9 at col. 7, lines 25-32 mentions prompting, when it recites:

9. The method as recited in claim 1 wherein the step of prompting the computer user to enter the call request comprises the step of

prompting the computer user to enter a name of the computer user; and

wherein the method comprises the step of indicating to the agent the name of the computer user before establishing voice communications between the agent and the computer user.

The Office, however, does not explain how the suggested “telephone number or name” indicates that a prompt of the user is to occur, in the manner claimed. Applicants respectfully request that the Office explain, as required by M.P.E.P. §2142, how any portion of Dezonno teaches, suggests, or discloses Applicants’ feature to “wherein a user is prompted to select delivery of voice to the called party by one of the circuit switched network and the packet-based network, if such prompting is indicated by a user defined parameter.” Instead, Dezonno simply discloses “prompting the computer

user to enter a name of the computer user.” In other words, Dezonno teaches prompting a user to enter their name, and does not teach “prompt a user to select delivery of voice to the called party by one of the circuit switched network and the packet-based network, if such prompting is indicated by a user defined parameter.” Indeed, there is nothing in the text of Dezonno that even mentions “prompt[ing]” a user, even those sections describing cited FIG. 1 and FIG. 2, let alone as recited by Applicants’ claim 74. Dezonno only mentions “prompting” in the claims, which do not teach, suggest, or disclose the subject matter of Applicants’ claim 74. Therefore, Applicants respectfully submit that Dezonno does not remedy the admitted shortcoming of Berken, Richter, and Fuller with respect to claim 74, that claim 74 is not rendered unpatentable by the proposed combination of Berken, Richter, Fuller, and Dezonno, and that claim 74 is independently allowable over the cited art for at least the reasons set forth above. Applicants further respectfully submit that claims 75-80 recite similar language, were rejected over the same art for the same reasons, and are therefore also independently allowable over the cited art for at least the reasons set forth above.

Therefore, for at least the reasons set forth above, Applicants respectfully request that the rejections of claims 23, 24, 27, 30, 31, 35, 37, 38, 42-46, 48, 49, 51-56, and 74-80 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. The Proposed Combination Of Berken, Hutton, And Reimer Does Not Render Claims 60-62 And 68-73 Unpatentable

Claims 60-62 and 68-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, and further in view of Reimer. Applicants respectfully traverse the rejection.

With regard to independent claim 60, Applicants respectfully submit that claim 60 recites “[o]ne or more circuits for use in a handheld communication device supporting the exchange of voice over a communication network, the one or more circuits comprising: at least one interface to circuitry for transmitting and receiving over a radio frequency channel, packets comprising packetized digital voice data according

to a packet protocol, wherein a packet is a unit of information transmitted as a whole from one device to another over the communication network.” In addition, claim 60 recites that the “at least one processor” comprises “at least one processor operably coupled to the at least one interface, the at least one processor operating to, at least, convert analog voice signals at a first user location to first digital voice data; packetize the first digital voice data according to the packet protocol to produce first digital voice data packets, wherein the first digital voice data packets comprise destination information used for routing the first digital voice data packets through the communication network to a second user, and wherein the first digital voice data is not packetized for transmission when representative of audio signals below a predetermined threshold level.” Claim 60 also requires that the “at least one processor” operates to “compare a destination address to a database having at least one entry comprising user defined call routing information and at least one associated destination address; cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database; wirelessly transmit, in accordance with a wireless communication protocol, the first digital voice data packets.” Claim 60 further requires that the “at least one processor” operates to “wirelessly receive, in accordance with the wireless communication protocol, second digital voice data packets; depacketize the second digital voice data packets to produce second digital voice data; and convert the second digital voice data to analog voice signals at the location of the first user.” Applicants respectfully submit that the Office has not shown that the cited art teaches all aspects of claim 60, and has therefore not established a *prima facie* case of obviousness with respect to claim 60 or any claims that depend therefrom.

Initially, Applicants respectfully note that claim 60 recites, in part, “compare a destination address to a database having at least one entry comprising user defined call routing information and at least one associated destination address,” and “cause delivery of voice to a called party by a user selected one of a circuit switched network and a packet-based network according to a destination address of the called party and the database.” Applicants respectfully submit that **the Office fails to even address**

these aspects of claim 60. See Office action of August 17, 2010 at pages 26-29. Therefore, for at least this reason, Applicants respectfully submit that a *prima facie* case of obviousness has not been established, and that claim 60 and its dependent claims are allowable over the cited art for at least this reason alone. Applicants respectfully submit that claim 60 is allowable for at least an additional reason.

The Office recognizes the following shortcomings of Berken and Hutton, at page 29 of the August 17, 2010 Office action:

Neither Berken nor Hutton explicitly discloses the first digital voice data is "not transmission [sic] when representative of audio signals below a predetermined threshold level". However, Reimer discloses the first digital voice data is not packetized for transmission when representative of audio signals below a predetermined threshold level (see FIG. 5, Steeps 52,54,55,58; speech digital data is not framed/packetized for transmission by waiting when speech signal is lower than predetermined threshold; see 6, line 10-32).

To begin, Applicants respectfully submit that the Office has not even asserted that the proposed combination of Berken and Hutton teaches or suggests Applicants' claim feature "wherein the first digital voice data is not packetized for transmission when representative of audio signals below a predetermined threshold level." Applicants' claim does not recite "not transmission when representative of audio signals below a predetermined level," as suggested by the Office. The Office seemingly recognizes the full detail of claim 60, however, by stating that the combination of Berken and Hutton does not teach at least this aspect of claim 60, when the Office states "[h]owever, Reimer discloses the first digital voice data is not packetized for transmission when representative of audio signals below a predetermined threshold level...." The Office then goes to assert, in part, that "FIG, Steeps [sic] 52, 54, 55 [sic, 56], 58" teach "speech digital data is not framed/packetized for transmission by waiting when speech signal is lower than predetermined threshold." Applicants respectfully disagree, and

now review the cited portion of Reimer at col. 6, lines 10-32, which describes cited FIG.

5. The cited portion of Reimer at col. 6, lines 10-32 is reproduced below:

Referring to FIG. 5, an input signal is sampled at 50 in frames of approximately 25 milliseconds until speech is detected at 52 by receipt of two consecutive **frames** of non-zero zero-crossings, whereupon execution of the game program is interrupted at 54. Sampling then continues until either a high frequency frame (i.e., a frame having a number of zero-crossings which exceeds a preselected threshold) is detected or four low frequency frames are detected. That **frame or collection of frames** is treated as a first or "beginning" portion of the word and is characterized as high frequency or low frequency at 56 depending upon whether a high frequency **frame** was detected. The program then "waits" an additional six frames at 58 and 60. The first non-zero zero-crossing **frame** thereafter marks the beginning of the second or "ending" portion of the word and its frequency determines the frequency level (i.e., high or low) at 62 and 64 of the second word portion. Sampling continues until the end of speech is detected by receipt of five consecutive **frames** of zero zero-crossings at which point the command is "recognized" by the frequency level of the constituent portions and the appropriate command issued at 66, 68 , 70, and 72.

(bold and underline added)

The cited portion of Reimer shown above teaches that an input signal is sampled in "frames" of approximately 25 milliseconds. While the Applicants neither agree nor disagree, the Office equates Applicants' "packetiz[ation]" with the "framing" of Reimer. See August 17, 2010 Office action at page 29. Reimer teaches that when speech is detected, execution of a game program is interrupted, but sampling continues. When a "high-frequency frame" or four "low frequency frames" are detected, that frame or collection of frames is treated as a first or "beginning" portion of a word and is characterized as high frequency or low frequency depending upon whether a high frequency frame was detected. Reimer teaches that the game program then waits an additional six frames. Thus, Reimer teaches that framing of speech samples is still occurring. Reimer goes on to teach that the first non-zero zero-crossing frame

thereafter marks the beginning of the second or "ending" portion of the word and its frequency determines the frequency level (i.e., high or low) at 62 and 64 of the second word portion. Reimer also explains that sampling continues until the end of speech is detected by receipt of five consecutive frames of zero zero-crossings at which point the command is "recognized" by the frequency level of the constituent portions and the appropriate **command** issued.

Applicants respectfully note that while Reimer states that "sampling continues until the end of speech," Reimer does not state that sampling ends at that point, nor does Reimer state that framing ends at any point. Indeed, Reimer teaches that "the end of speech is detected by receipt of five consecutive **frames** of zero zero-crossings," thus framing must be occurring to detect the end of speech. Therefore, for at least these reasons, Applicants respectfully submit that it is not true that Reimer teaches "speech digital data is not framed/packetized for transmission by waiting when speech signal is lower than predetermined threshold," as asserted by the Office. Indeed, Reimer is quite clear that framing, which the Office associates with Applicants' packetization, is occurring throughout the process of FIG. 5, as demonstrated in the cited portion of Reimer at col. 6, lines 10-32. Therefore, Applicants respectfully submit that Reimer does not teach, suggest, or disclose "the first digital voice data is not packetized for transmission when representative of audio signals below a predetermined threshold level," as asserted by the Office. Applicants respectfully submit that Reimer therefore does not remedy the admitted shortcomings of Berken and Hutton, and that claim 60 is allowable over the proposed combination of Berken, Hutton, and Reimer, for at least this reason. Applicants believe that claim 60 is allowable over the cited art for at least an additional reason.

Applicants respectfully submit that Applicants' claim 60 recites, in part, "wherein the first digital voice data is not packetized for transmission when representative of audio signals below a predetermined threshold level." Applicants further respectfully submit that Applicants' claim 60 recites that "transmission" is to "wirelessly transmit, in accordance with a wireless communication protocol." Reimer, however, fails to teach transmission of the framed speech data, and instead teaches that "[s]ampling continues

until end of speech is detected by receipt of five consecutive frames of zero zero-crossings at which point the **command** is "recognized" by the frequency level of the constituent portions and the appropriate **command** issued at 66, 68, 70, 72." Thus, Reimer teaches recognition and issuance of a "command," and fails, however, to teach, suggest, or disclose that framed speech is transmitted, let alone "wirelessly transmit[ed], in accordance with a wireless communication protocol," as claimed. Therefore, Applicants respectfully submit that Reimer does not teach, suggest, or disclose at least this aspect of claim 60 that the Office admitted is also not disclosed by either Berken or Hutton, that the propose combination of Berken, Hutton, and Reimer therefore cannot teach, suggest, or disclose at least this aspect of claim 60, and that claim 60 is allowable over the cited art for at least this additional reason.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness with respect to claim 60, as required by M.P.E.P. §2142, that claim 60 is not rendered unpatentable by the cited art, and that claim 60, and any claims that depend therefrom, are allowable over the proposed combination of Berken, Hutton, and Reimer. Accordingly, Applicants respectfully request that the rejection of claims 60-62 and 68-73 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. The Proposed Combination Of Berken, Hutton, And Reimer With Any Of Lewen, McKee, Cripps And Dezonno Does Not Render Claims 63-67 And 81 Unpatentable

Claims 63-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Hutton, and Reimer, in further view of Lewen. Claim 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Hutton, Reimer, and Lewen, in further view of McKee. Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Hutton, and Reimer, in further view of Cripps. Claim 81 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken, Hutton, and Reimer, in further view of Dezonno. Applicants respectfully traverse the rejections.

Applicants respectfully submit that claims 63-67 and 81 depend from independent claim 60 that has been shown to be allowable over the cited art. Applicants respectfully submit that claims 63-67 and 81 are therefore also allowable for at least the reasons set forth above with respect to claim 60. Applicants respectfully submit that claim 81 is allowable for at least an additional reason.

With specific regard to claim 81, Applicants respectfully submit that the Office cites over a full page of Dezonno, but fails to specifically identify and explain, **as required by M.P.E.P. §2142**, what of the cited portions of Dezonno teaches Applicants' claim 81, **and how**. M.P.E.P. §2142 clearly recognizes that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness," that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious," and that "the analysis supporting a rejection under 35 U.S.C. 103 **should be made explicit**." M.P.E.P. §2142 also recognizes that "**rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**"

Applicants' claim 81 recites "prompt a user to select delivery of voice to the called party by one of the circuit switched network and the packet-based network, if such prompting is indicated by a user defined parameter." The Office admits that "Berken and Hutton fails to explicitly disclose a user is "*prompted*." See August 17, 2010 Office action at page 34. Applicants respectfully submit that the deficiencies of Berken and Hutton are not limited to "prompted." Applicants respectfully submit that the Office has not shown where the cited art teaches the remaining aspects of claim 81.

In addition, Applicants respectfully submit that the Office does not explain what of Dezonno is being identified as corresponding to Applicants' claimed "prompt a user," and how Dezonno teaches how a "telephone number or name" entered by a user, as in Dezonno, indicates that "prompting" should occur. Of the cited portions of Dezonno, only the text of claim 9 at col. 7, lines 25-32 mentions prompting, when it recites:

9. The method as recited in claim 1 wherein the step of prompting the computer user to enter the call request comprises the step of

prompting the computer user to enter a name of the computer user; and

wherein the method comprises the step of indicating to the agent the name of the computer user before establishing voice communications between the agent and the computer user.

The Office, however, does not explain how the suggested "telephone number or name" indicates that a prompt of the user is to occur. Applicants respectfully request that the Office explain, as required by M.P.E.P. §2142, how any portion of Dezonno teaches, suggests, or discloses Applicants' feature to "prompt a user to select delivery of voice to the called party by one of the circuit switched network and the packet-based network, if such prompting is indicated by a user defined parameter." Instead, Dezonno simply discloses "prompting the computer user to enter a name of the computer user." In other words, Dezonno teaches prompting a user to enter their name, and does not teach "prompt a user to select delivery of voice to the called party by one of the circuit switched network and the packet-based network, if such prompting is indicated by a user defined parameter." Indeed, there is nothing in the text of Dezonno that even mentions "prompt[ing]" a user, let alone as recited by Applicants' claim 81. Dezonno only mentions "prompting" in the claims, which do not teach, suggest, or disclose the subject matter of Applicants' claim 81. Therefore, Applicants respectfully submit that Dezonno does not remedy the admitted shortcoming of Berken and Hutton with respect to claim 81, that claim 81 is not rendered unpatentable by the proposed combination of Berken, Hutton, and Dezonno, and that claim 81 is independently allowable over the cited art for at least the reasons set forth above.

Accordingly, Applicants respectfully request that the rejections of claims 63-67 and 81 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-81 define patentable subject matter and are in condition for allowance.

Should the Examiner disagree or have any questions regarding this submission, or have any suggestions to move the Application to allowance, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees required by this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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